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REMARKS-GENERAL

All claims are rejected under 35 U.S.C. 103(a), based on combinations of Sotomayor and Meske. The rejection of claim 42 additionally cites Buguraev. The applicant respectfully disagrees with this line of reasoning, for the following reasons:

1. Combination of Sotomayor and Meske in the manner suggested by the Examiner does not result in the claimed invention.
2. Even if combination of the references arrived at the present invention, it is inappropriate to combine the cited references in the manner suggested.
 - a) No motivation to combine Sotomayor, Meske, or Buguraev is described in the O.A.
 - b) Sotomayor, Meske, and Buguraev are individually complete, and solve different problems from the present invention.
3. Sotomayor teaches away from the present invention and from combination with Meske.
4. Rejections of dependent claims are inappropriate.

The References And Differences Of The Present Invention Thereover

Prior to discussing the claims and the above points, applicant will first discuss the references and the general novelty of the present invention and its unobviousness over the references.

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Sotomayor (U.S. patent number 5,708,825) discloses a method for generating a summary page from one or more documents that are selected by an author, such that significant key topics within the documents are linked to from the summary page. Thus, the method disclosed by Sotomayor is a scheme for generating an index (to one or more documents), which may be appended to a source document. In column 5, line 53- column 7, line 10, the use of a web browser to view documents is described. However, in describing access to documents over the internet, Sotomayor states, "One problem with accessing documents over the Internet is that many documents are quite long, and thus can take quite some time to download over the network. This means that viewers are often reluctant to access a document unless they know it will be useful. The present invention facilitates dividing documents into a plurality of pages which can be efficiently chosen by a viewer and downloaded, one page at a time, and only when the particular page desired is referenced" (col 6, line 65-col. 7, line 6). Thus, the purpose of Sotomayor is to *decrease* the amount of material that a user must look at in order to find desired information. Sotomayor does not anticipate use of its indexing method in the context of a specific reader request for display of electronic text. According to Sotomayor, the summary page is generated prior to the reader's request for display of text. Thus, the search of the index (col. 3, line 41 – col. 4, line 8 and col. 15, line 48-67 and abstract) is completely unrelated to a reader's request for display of electronic text, and

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clearly does not occur after that request for display, as is required by the limitation that steps a-e of the pending application occur in sequence.

Meske (U.S. patent number 5,530,852) discloses a computer-implemented method and system for retrieving information, using as input mark-up language-containing files that describe the information to be retrieved (the first second, and third files), and which are created in response to a specific user request from within a browser (column 2, line 64-65, Fig. 4, #440, column 5, lines 60-64). The retrieved information may be presented either in brief (the fourth file) or in complete (the fifth file) form. Thus, in response to a specific user query, this system can intermittently provide links to or retrieve articles related to that query.

Buguraev (U.S. Patent Number 6,212,494) describes a method to extract linguistic information from documentation to create an online help database. A merged file is used to identify key terms that are used for searching.

The **claimed invention** is a method for using a computer system, in response to a reader's request for display of electronic text, to automatically identify and provide additional reading material related to concepts referred to within said electronic text comprising, in sequence, the steps of:

- a) accessing, using the reader's computer, electronic text requested for display by the reader, said electronic text containing at least one text section;
- b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section;
- c) responsive to said search request, automatically searching an index, wherein

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- i) said index contains a plurality of terms by which it may be searched;
- ii) substantially all terms in said index are associated with at least one pointer to a text section; and
- iii) at least one term in said index is associated with a plurality of pointers, at least two of said plurality of pointers pointing to different text sections;
- d) responsive to step (c), automatically identifying additional reading material related to said concept; and
- e) automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a).

1. Combination of Sotomayor and Meske in the manner suggested by the Examiner does not result in the claimed invention.

According to the Office Action, Sotomayor discloses steps a) and c). However, as noted, Sotomayor does not disclose these steps in sequence (and in fact, requires them to be carried out in reverse order), and teaches against step c in the context of accessing an entire document (as often occurs in step a of the claimed invention). Moreover, the claimed invention requires step c) to take place *responsive to said search request* (from step b). Since Sotomayor does not disclose the automatic generation of a search request, it would not be possible for step c) to take place with this limitation in Sotomayor.

According to the Office Action, Meske discloses steps b), d), and e). The O.A. does not cite the specific passages of Meske that correspond to each of the limitations in steps b), d), or e). However, the search request of Meske is not

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automatically formulated, as is required by step b), using said at least one text section (from step a). In fact, the search request of Meske is formulated based on specific input from a user regarding the type of information that the user desires to search for, and thus, cannot be construed to be automatically formulated. While the search request of Meske is processed into a markup language, this markup language describes the specific search terms entered by the user on a form in a browser, and does not anticipate the automatic use of electronic text requested for display to a user in order to formulate a search request. Moreover, Meske does not disclose the automatic identification of additional reading material responsive to an index search with the limitations of claim 36c, as is required by 36d. In addition, neither Meske nor Sotomayor discloses the display of an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a). As was pointed out by Examiner Shah in the interview of 3/30/04, one unique source of functionality of the invention (as demonstrated during the interview) is the concomitant display of the requested text, together with this indicator, in a side-by-side fashion. This unique feature is also not provided by either of the cited references.

2. Even if combination of the references arrived at the present invention, it is inappropriate to combine the cited references in the manner suggested.

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The O.A. makes clear that individually, none of the prior art references anticipate or render the present invention obvious.

a) No motivation to combine Sotomayor, Meske, or Buguraev is described in the O.A.

The O.A. asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Meske, Jr. and Sotomayor. . . . Meske Jr. provides information retrieval. . ." (O.A., paragraph 6). However, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. No such suggestion or motivation is cited in the current rejection, and in fact, no such suggestion or motivation exists in either reference or in the knowledge generally available to one of ordinary skill in the art at the time the application was filed.

Moreover, the combination of Sotomayor and Meske is very strained. While the claimed invention requires steps a)-e) to occur in sequence, in the combination described in the O.A., step a) from Sotomayor would need to be combined with step b) from Meske, which would need to be combined with step c) from Sotomayor, which would need to be combined with steps d) and e) from Meske. Certainly, no motivation exists to combine these inventions in this highly novel way.

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Applicant respectfully requests, that if the claims are rejected on any combination of references, that the Examiner include an explanation, in accordance with MPEP 706.02, Ex parte Clapp, 27 USPQ 972 (BPAI 1985), and Ex parte Levengood, 28 USPQ2d 1300 (BPAI 1993), of a "factual basis to support his conclusion that it would have been obvious" to make the combination.

b) Sotomayor, Meske, and Bugaraev are individually complete, and solve different problems from the present invention.

Because Sotomayor, Meske, and Bugaraev each describe complete inventions (see above summaries), each reference further lacks motivation for any combinations with other inventions. Each reference is complete and functional in itself, so there would be no reason to use parts from, or add or substitute parts to, any reference.

Moreover, applicant's invention solves a different problem than the references, and such different problem is recited in the claims (In re Wright, 6 USPQ2d 1959 (1988)). In particular, the present invention provides "additional reading material related to concepts referred to within said electronic text" (Claim 36) a problem clearly not addressed by any of the cited prior art. As already discussed, Sotomayor provides a means of generating an index to one or more documents, reducing the amount of material that a user must look at in order to find desired information, Meske provides a user with a means of searching

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articles for relevance to topics input by the user, and Buguraev solves a problem related to creation of an online help database.

3. Sotomayor teaches away from the present invention and from combination with Meske.

As noted, Sotomayor provides a means for reducing the amount of material that a user must review in order to find desired information. Meske is a means of retrieving additional information in response to a search request. Since Sotomayor is involved in decreasing the amount of information presented, it teaches away from combinations with Meske.

One object of the present invention is to provide a reader with additional reading material. Thus, the goals of Sotomayor and the present invention are also mutually exclusive, and thus, it is inappropriate to use Sotomayor in a determination of obviousness of the present invention.

4. Rejections of dependent claims are inappropriate.

The additional limitation in claim 37 is rejected (O.A. paragraph 7) based on Sotomayor. However, Claim 37 limits 36(d), which the Examiner expressly acknowledges is not disclosed by Sotomayor (O.A. page 4). The applicant respectfully submits that the network of Sotomayor is irrelevant to the additional reading material of step (d), which the O.A. asserts to be disclosed not by

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are not disclosed by Sotomayor (O.A. page 4). The applicant respectfully submits that various steps within Sotomayor are irrelevant to the concepts in steps (b) or (d), which the O.A. asserts to be disclosed not by Sotomayor, but by Meske (page 5). Moreover, it would not be appropriate to reject claims 52, 53, or 54 based on the combination of Sotomayor and Meske, without specific motivation for this precise combination.

Claims 59, 60, 61, which are dependent on claim 36, are rejected based solely on disclosures within Sotomayor. However, these claims limit 36(e), referring to display and indicators of additional reading material, which the Examiner expressly acknowledges is not disclosed by Sotomayor (O.A. page 4). The applicant respectfully submits that displays or indicators in Sotomayor are irrelevant to the display and indicators of additional reading material in step (e), which the O.A. asserts to be disclosed not by Sotomayor, but by Meske (page 5). Moreover, it would not be appropriate to reject claims 59, 60 or 61 based on the combination of Sotomayor and Meske, without specific motivation for this precise combination.

Claims 62 and 63, which are dependent on claim 36, are rejected based solely on disclosures within Sotomayor. However, these claims limits 36(d), referring to relationships between references to concepts, which the Examiner expressly acknowledges is not disclosed by Sotomayor (O.A. page 4). The applicant respectfully submits that concepts in Sotomayor are irrelevant to relationships between references to concepts in step (d), which the O.A. asserts to be disclosed not by Sotomayor, but by Meske (page 5). Moreover, it would not

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Sotomayor, but by Meske (page 5). Moreover, it would not be appropriate to reject claim 37 based on the combination of Sotomayor and Meske, without specific motivation for this precise combination.

Claim 38, which is dependent on Claim 37, is also rejected (O.A. paragraph 8) based on Sotomayor. However, Claim 37 limits 36(d), which the Examiner expressly acknowledges is not disclosed by Sotomayor (O.A. page 4). The applicant respectfully submits that the internet of Sotomayor is irrelevant to the additional reading material of step (d), which the O.A. asserts to be disclosed not by Sotomayor, but by Meske (page 5). Moreover, it would not be appropriate to reject claim 38 based on the combination of Sotomayor and Meske, without specific motivation for this precise combination.

Claims 41, 44, 45, 46, 47, and 50, which are dependent on Claim 36, are also rejected based solely on disclosures within Sotomayor. However, these claims limit 36(b), which the Examiner expressly acknowledges is not disclosed by Sotomayor (O.A. page 4). The applicant respectfully submits that various steps within Sotomayor are irrelevant to the automatic formulation of a search request of step (b), which the O.A. asserts to be disclosed not by Sotomayor, but by Meske (page 5). Moreover, it would not be appropriate to reject claims 41,44,45, 46, 47 or 50 based on the combination of Sotomayor and Meske, without specific motivation for this precise combination.

Claim 52, 53, and 54, which are dependent on claim 36, are rejected based solely on disclosures within Sotomayor. However, these claims limit 36(b) and 36(d), referring to concepts, which the Examiner expressly acknowledges

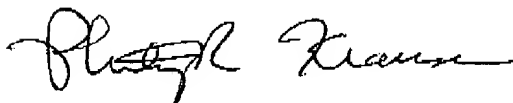
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be appropriate to reject claims 62 or 63 based on the combination of Sotomayor
and Meske, without specific motivation for this precise combination.

Conclusion

The applicant submits that the claims are proper, definite, and define novel
structure which is also unobvious. The applicant further submits that this
application is now in condition for allowance, which action he respectfully solicits.

Very Respectfully,



Philip R Krause

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I certify that on the date below, I will fax this communication and attachments, if
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Inventor's signature: 